UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,682	01/31/2001	Jeremy Burr	INTL-0456-US (P9810)	8497

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EXAMINER
TRAN, PHILIP B

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _3/7/2005_.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1-16 and 18-32_ is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1-16 and 18-32_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).

2.   Claims 1-16 and 18-32 are rejected under 35 U.S.C. § 103(a) as being

unpatentable over Gudjonsson et al (Hereafter, Gudjonsson), U.S. Pat. No. 6,564,261.

Regarding claim 1, Gudjonsson teaches a method comprising:

enabling the storage of a modifiable list of selected second terminals (= contact

list or buddy list) [see Col. 35, Lines 38-44] that a first terminal other than a selected

second terminal is able to communicate with (= database (13) contains the contact list

for each user) [see Col. 28, Lines 34-46], said list maintained and modified by a first

user (= adding or removing users to/from the contact list with authentication) [see Col.

27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59]; and

based on said list, enabling communications between a first terminal and second

terminals when a second user is using said first terminal (= enabling communication

services between users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8,

Lines 6-46].

Gudjonsson does not explicitly teach a second user other than the first user is

using the first terminal. However, it would have been obvious to one of ordinary skill in

the art at the time of the invention was made to recognize that multiple users can use

the same terminal to communicate with other terminals in the network. One would be

motivated to share the same terminal in order to reduce the cost of purchasing more

equipment.

Regarding claim 2, Gudjonsson further teaches including communicating

between a first terminal and a base station and forwarding communications from said

first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-

46] to said base station (= cluster) [see Figs. 1 & 13] on to said second terminals (=

other users (7) of clients (11)) (= communication between users and the cluster such as

a collection of servers and database) [see Figs. 1 &13].

Regarding claim 3, Gudjonsson further teaches including enabling

communications between a first terminal that is a handheld unit (= mobile phone or

PDA) [see Col. 8, Lines 18-20] and said base station (= cluster) [see Figs. 1 & 13] using

a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7,

Lines 35-60].

Regarding claim 4, Gudjonsson further teaches including communicating

between said base station and said second terminals at least in part over the Internet (=

the cluster (= a collection of servers and database) communicates with other entities

such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 5, Gudjonsson further teaches including exchanging text

messages between said first terminal and selected second terminals (= real-time text

chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 6, Gudjonsson further teaches including communicating

between said first terminal and said selected second terminals through a chat server (=

establishing a communication session such as voice chat or text chat between users

using one or more cluster network (= a collection of servers and database)) [see Col. 3,

Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 7, Gudjonsson further teaches including storing said modifiable

list of second terminals in said base station (= database (13) contains the contact list for

each user) [see Col. 28, Lines 34-46].

Regarding claim 8, Gudjonsson further teaches including blocking communications, from said handheld unit, received by said base station and preventing those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 9, Gudjonsson further teaches enabling a requirement for a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 10, Gudjonsson further teaches including requiring a password to initiate an outgoing transmission from said first terminal (= authentication with user identity and password) [see Col. 11, Lines 35-43 and Col. 31, Lines 43-59].

Claim 11 is rejected under the same rationale set forth above to claim 1.

Regarding claim 12, Gudjonsson further teaches storing instructions that enable the processor-based system (= cluster) [see Figs. 1 & 13] to communicate with a first terminal and forward communications from said first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] to said second terminal (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 &13].

Regarding claim 13, Gudjonsson further teaches storing instructions that enable communications with a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 14, Gudjonsson further teaches storing instructions that enable the processor-based system to communicate with said second terminals at least in part over the Internet (= the cluster such as a collection of servers and database communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 15, Gudjonsson further teaches storing instructions that enable the processor-based system to exchange text messages between a first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 16, Gudjonsson further teaches storing instructions that enable

the processor-based system to communicate between said first terminal and said

selected second terminals through a chat server (= establishing a communication

session such as voice chat or text chat between users using one or more cluster

network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24,

Lines 32-39].

Regarding claim 18, Gudjonsson further teaches storing instructions that enable

the processor-based system to block communications from said handheld unit and

prevent those communications from proceeding to a second terminal not listed in said

modifiable list (= connections between services and/or users are going through a

special inter-cluster service which can limit what services are actually available [see

Col. 8, Lines 29-32] and communications between users are initiated by the invitation

wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the

service management server keep a list of users that may enter the conference [see Col.

28, Lines 3-6]. Therefore, communications between the first terminal and the second

terminal are not directly but being controlled and blocked by the inter-cluster-service of

the cluster (= base station)).

Regarding claim 19, Gudjonsson further teaches storing instructions that enable

the processor-based system to enable a requirement for a password to obtain access to

said list (= authenticating and accessing contact list with a password) [see Col. 11,

Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 20, Gudjonsson further teaches storing instructions that enable

the processor-based system to require a password to initiate an outgoing transmission

from said first terminal (= authentication with user identity and password) [see Col. 11,

Lines 35-43 and Col. 31, Lines 43-59].

Regarding claim 21, Gudjonsson teaches a system comprising:

a processor-based device (= the cluster or a collection of servers and database)

[see Figs. 1 & 13]; and

a storage (= database (13)) [see Figs. 1 & 13] coupled to said processor-based

device storing instructions that enable the storage of a modifiable list of second

terminals (= contact list or buddy list) [see Col. 35, Lines 38-44] that a first terminal is

able to communicate with (= database (13) contains the contact list for each user) [see

Col. 28, Lines 34-46], said modifiable list accessible to a first user and not a second

user (= adding or removing users to/from the contact list with authentication) [see Col.

27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59], enable

communications between said first terminal and a listed second terminals when the

second user is using said first terminal (= enabling communication services between

users (7) of clients (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46].

Gudjonsson does not explicitly teach a second user other than the first user is using the first terminal. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to recognize that multiple users can use the same terminal to communicate with other terminals in the network. One would be motivated to share the same terminal in order to reduce the cost of purchasing more equipment.

Regarding claim 22, Gudjonsson further teaches including a wireless interface (= Wireless Application Protocol (WAP) [see Col. 7, Lines 35-60]. Since wireless application protocol is using, a wireless interface is implemented [see Figs. 1 & 13]).

Regarding claim 23, Gudjonsson further teaches said storage stores instructions that enable said device to communicate with a first terminal (= user (7) of client (11)) [see Figs. 1 & 2 and Abstract and Col. 8, Lines 6-46] and forward communications from said first terminal to said second terminal (= other users (7) of clients (11)) (= communication between users and the cluster (= a collection of servers and database)) [see Figs. 1 &13].

Regarding claim 24, Gudjonsson further teaches said storage stores instructions that enable communications between a first terminal that is a handheld unit (= mobile phone or PDA) [see Col. 8, Lines 18-20] using a wireless communication protocol (= Wireless Application Protocol (WAP)) [see Col. 7, Lines 35-60].

Regarding claim 25, Gudjonsson further teaches said storage stores instructions that enable the processor-based device to communicate with said second terminals at least in part over the Internet (= the cluster (= a collection of servers and database) communicates with other entities such as clients, other clusters and/or Internet) [see Fig. 13 and Col. 4, Lines 56-60].

Regarding claim 26, Gudjonsson further teaches said storage stores instructions that enable the processor-based system to exchange text messages between a first terminal and selected second terminals (= real-time text chat session between the users) [see Col. 13, Lines 10-19].

Regarding claim 27, Gudjonsson further teaches said storage stores instructions that enable the device to communicate between said first terminal and selected second terminals through a chat server (= establishing a communication session such as voice chat or text chat between users using one or more cluster network (= a collection of servers and database)) [see Col. 3, Lines 46-63 and Col. 24, Lines 32-39].

Regarding claim 28, Gudjonsson further teaches said storage stores instructions that enable the device to store said modifiable list of second terminals (= database (13) contains the contact list for each user) [see Col. 28, Lines 34-46].

Regarding claim 29, Gudjonsson further teaches said storage stores instructions that enable the device to block communications from said handheld unit and prevent those communications from proceeding to a second terminal not listed in said modifiable list (= connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station)).

Regarding claim 30, Gudjonsson further teaches said storage stores instructions that enable the device to require a password to obtain access to said list (= authenticating and accessing contact list with a password) [see Col. 11, Lines 35-64 and Col. 27, Lines 5-16].

Regarding claim 31, Gudjonsson further teaches including restricting said second user from the ability to modify said list (= adding or removing users to/from the contact list with authentication and accessing contact list with user identity and password) [see Col. 11, Lines 35-45 and Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

Regarding claim 32, Gudjonsson further teaches storing instructions that enable

the processor-based system to enable restrictions on the ability of the second user to

modify said list (= adding or removing users to/from the contact list with authentication

and accessing contact list with user identity and password) [see Col. 11, Lines 35-45

and Col. 27, Lines 5-16 and Col. 27, Lines 36-44 and Col. 31, Lines 43-59].

Response to Arguments

3.   Applicant's arguments have been fully considered but they are not persuasive

because of the following reasons:

Gudjonsson teaches a method and system comprising enabling the storage of a

modifiable list of selected second terminals such as contact list or buddy list [see Col.

35, Lines 38-44] that a first terminal is able to communicate with (that is, database (13)

contains the contact list for each user) [see Col. 28, Lines 34-46], said list maintained

and modified by a first user. For example, Gudjonsson teaches adding or removing

users to/from the contact list with authentication [see Col. 27, Lines 5-16 and Col. 27,

Lines 36-44 and Col. 31, Lines 43-59]. In addition, Gudjonsson further teaches based

on said list, enabling communications between a first terminal and second terminals

when a second user is using said first terminal. For example, Gudjonsson discloses

enabling communication services between users (7) of clients (11) [see Figs. 1 & 2 and

Abstract and Col. 8, Lines 6-46]. Gudjonsson does not explicitly teach a second user

other than the first user is using the first terminal. However, it would have been obvious

to one of ordinary skill in the art at the time of the invention was made to recognize that

multiple users can use the same terminal to communicate with other terminals in the

network. One would be motivated to share the same terminal in order to reduce the cost of purchasing more equipment.

Applicant argued that "Gudjonsson fails to address restricting communications of one user based on a list that is maintained and modified by another user of his system."

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., restricting communications of one user based on a list that is maintained and modified by another user of his system) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, **988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).**

In addition, applicant argued that Gudjjonsson fails to disclose blocking communications to a second terminal that is not on a modifiable list.

In response to applicant's argument, blocking communications to a second terminal that is not on a list can be interpreted broadly in many ways. For example, Gudjjonsson discloses connections between services and/or users are going through a special inter-cluster service which can limit what services are actually available [see Col. 8, Lines 29-32] and communications between users are initiated by the invitation wherein the routing service can ignore the invitation [see Col. 9, Lines 8-40] and the service management server keep a list of users that may enter the conference [see Col. 28, Lines 3-6]. Therefore, communications between the first terminal and the second

terminal are not directly but being controlled and blocked by the inter-cluster-service of the cluster (= base station) regardless of terminal being on a list or not.

As a result, cited prior art does disclose a system and method as broadly claimed by the applicant. Applicant has still failed to identify specific claimed limitations that would define a clearly patentable distinction over prior arts. For example, "enabling communications between the first and second terminals when a second user other than the first user is using the first terminal" is not the novelty of the invention because multiple users can use the same terminal to communicate with other terminals in the network.

Therefore, the examiner asserts that cited prior art teaches or suggests the subject matter recited in independent claims. Dependent claims are also rejected at least by virtue of dependency on independent claims and by other reasons shown above. Accordingly, claims 1-16 and 18-32 are respectfully rejected.

Other References Cited

4.   The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Shah, U.S. Pat. Application Pub. No. US 2001/0013050 A1.

B) Pennock et al, U.S. Pat. No. 6,807,562.

C) Morris et al, U.S. Pat. No. 6,336,133.

D) DeSimone et al, U.S. Pat. No. 6,212,548.

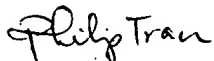E) Cooper et al, U.S. Pat. No. 6,754,904.

F) Granstam et al, U.S. Pat. No. 6,587,691.

5.   A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS

SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS

COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR

RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C.

§ 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF

37 CAR 1.136(A).

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Philip Tran whose telephone number is (571) 272-3991.

The Group fax phone number is (703) 872-9306.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Hosain T. Alam, can be reached on (571) 272-3978.

    Any inquiry of a general nature or relating to the status of this application should

be directed to the Group receptionist whose telephone number is (703) 305-3900.

Philip Tran

Philip B. Tran
Art Unit 2155
April 15, 2005